

Amendments to the Drawings:

The attached sheet of drawings includes changes to Figure 2. This sheet, which includes Figure 2, replaces the original sheet. In Figure 2, previously omitted element 33 has been added.

Attachment: Replacement Sheet
Annotated Sheet Showing Changes

Remarks:

1. Claims 1 through 39 were originally presented in this application. No claims have been added or canceled in this response. Claims 1-39 remain pending.

2. In Paragraph 1 of the Office Action, the Examiner objected to the drawings as failing to comply with 37 CFR 1.83(a). In Paragraph 1 of the Office Action, the Examiner states: "the drill bit jet as recited in claim 11 must be shown or the feature(s) canceled from the claim(s)". Applicants submit corrected drawing sheets herewith in compliance with 37 CFR 1.121(d). Applicants refer the Examiner to new drawing sheet 2/4 in which FIGURE 2 has been amended to include reference to drill bit jets 33. Paragraph [0033] has also been amended in this paper to include notational reference 33. No new matter has been added.

3. In Paragraph 2 of the Office Action, the Examiner objected to the drawings because FIGURES 3A and 5A include section lines that are labeled alphanumerically instead of with Arabic or Roman numerals (37 CFR 1.84(h)(3)). Applicants respectfully traverse this objection. The section lines in FIGURES 3A and 5A are labeled according to common practice in that the labels '3B' and '5B' refer to the views shown on FIGURES 3B and 5B, respectively. Moreover, the section lines are labeled in accordance with 37 CFR 1.84(h)(3) in that they include the Arabic numbers '3' and '5'. Applicants respectfully request that the Examiner withdraw her objection in this regard.

4. In Paragraph 3 of the Office Action, the Examiner objected to the drawings as failing to comply with 37 CFR 1.84(p)(5) "because they do not include the following reference sign(s) mentioned in the description: 200, 223, 225, 234, 236, and 238." Applicants respectfully traverse this objection. Reference sign 200 is shown on FIGURES 1, 3A, 3B, and 3C. Regarding reference signs 223, 225, 234, 236, and 238, the Examiner is respectfully referred to Paragraph [0030] of the original specification, which states: "It will be understood that like-numbered items denote elements serving corresponding function and structure in the various tank assemblies 220A, 220B, 220C, 220D, 220E, and 220F. Thus a general reference herein to the pressure balancing chamber 226, for example, applies to each of the pressure balancing

chambers 226A, 226B, 226C, 226D, 226E, and 226F unless otherwise stated.” Accordingly, reference signs 223, 225, 234, 236, and 238 are shown, for example, on FIGURE 3A as 223A and 223B, 225A and 225B, 234A and 234B, 236A and 236B, and 238A and 238B, respectively. Applicants therefore respectfully request the Examiner withdraw her objection in this regard.

5. In Paragraph 4 of the Office Action, the Examiner objected to the drawings as failing to comply with 37 CFR 1.84(p)(5) “because they include the following reference character(s) no mentioned in the description: 222B, 223A, 223B, 225A, 225B, 234A, 234B, 236A, 236B, 238A, 238B, and 335. Applicants respectfully traverse this objection. Reference character 335 is mentioned in Paragraph [0041], line 4 of the original specification, which states in part: “sampling module 200 and formation tester 300 are shown coupled at 335.” Regarding reference characters 222B, 223A, 223B, 225A, 225B, 234A, 234B, 236A, 236B, 238A, and 238B, the Examiner is again respectfully referred to Paragraph [0030] of the original specification, which states: “It will be understood that like-numbered items denote elements serving corresponding function and structure in the various tank assemblies 220A, 220B, 220C, 220D, 220E, and 220F. Thus a general reference herein to the pressure balancing chamber 226, for example, applies to each of the pressure balancing chambers 226A, 226B, 226C, 226D, 226E, and 226F unless otherwise stated.” Accordingly, reference characters 222B, 223A, 223B, 225A, 225B, 234A, 234B, 236A, 236B, 238A, and 238B are referred to, for example, in Paragraph [0031] of the original specification as 222, 223, 225, 234, 236, and 238, respectively. Applicants therefore respectfully request the Examiner withdraw her objection in this regard.

6. In Paragraph 5 of the Office Action, the Examiner objected to the abstract of the disclosure because it included the implied phrases “is provided” and “is also provided.” Applicants have amended the abstract to address this issue.

7. In Paragraph 7 of the Office Action, the Examiner objected to claims 1, 6-9, 14, 15, 22, 25, 29, 32, 33, 35, 36, and 38 as being “replete with errors.” Specific examples of the objectionable claim language were given. The examiner stated: “All of the claims should be reviewed for similar informalities and the appropriate corrections made. Appropriate correction

is required.” While Applicants do not necessarily concur that the claim language as originally filed is objectionable, Applicants have nonetheless amended claims 1, 6, 7, 8, 9, 14, 15, 16, 22, 25, 29, 32, 33, 35, 36, and 38 as requested. These amendments are ministerial and non-substantive in nature. They are not related to patentability, and are not intended to (and are not believed to) alter the scope and/or subject matter of the amended claims as originally presented.

8. In Paragraphs 8 and 9 (pages 5 through 8), claims 1-13, 18-31, 34-37 and 39 stand rejected in the Office Action under 35. U.S.C. 103(a) as being unpatentable over *Ringgenberg et al.* (US Patent 5,799,733) in view of *Michaels et al.* (US Patent 5,303,775). In particular, near the top of page 6, regarding independent claim 1, the examiner states: “*Ringgenberg et al.* discloses all of the limitations of the above claims except for the sample tank including an internal fluid separator that splits the tank into a sample chamber and a pressure balancing chamber. *Michaels et al.* disclose a tool similar to that of *Ringgenberg et al.* *Michaels et al.* further teaches a sample tank that includes an internal fluid separator for splitting the tank into a sample chamber and a pressure balancing chamber where the pressure balancing chamber is in fluid communication with the drilling fluid exterior to the tool collar.” The Examiner further states: “it would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified the at least one sample tank of *Ringgenberg et al.* to include the internal fluid separator taught by *Michaels et al.*”

9. Applicants disagree with this obviousness rejection. Applicants respectfully submit that the Examiner has failed to make a *prima facie* case of obviousness. MPEP § 2143 specifically requires that in order to make a *prima facie* case of obviousness, the Examiner must meet three criteria: (1) show some suggestion or motivation, either in the references themselves or in the knowledge of one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) articulate some reasonable expectation of success; and (3) show that the combined references teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant’s disclosure. *Id.* Furthermore, as the Federal Circuit has held, “to establish obviousness based on a combination of the elements disclosed in the prior art, there

must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant.” *In re Kotzab*, 271 F.3d 1365, 1370 (Fed. Cir. 2000). The Examiner “must provide particular findings” supporting a combination of prior art references. *Id.* Indeed, the Federal Circuit has emphasized the need for a “rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999); *see also In re Fine*, 837 F.2d 1071, 1074-75 (Fed. Cir. 1988).

10. Further, Applicants respectfully disagree with the Examiner’s statements in Paragraphs 8 and 9 of the Office Action because they are merely conclusory, contrary the requirements of MPEP § 2143. Specifically, for example, it is merely conclusory to state, without more, that “it would have been considered obvious to one having ordinary skill in the art” to combine *Ringgenberg et al.* and *Michaels et al.* Such statements do not point to any teaching, or even any suggestion, in either of the references that they should be combined as suggested by the Examiner. Such statements further do not articulate from the references themselves why any such combination would meet with any reasonable expectation of success, again contrary to MPEP § 2143.

11. Their disagreement with the Examiner regarding the obviousness rejection notwithstanding, however, Applicants have amended independent claims 1, 22, 35, and 36 solely in the spirit of cooperation with the Examiner so as to allow progress of prosecution. As amended, claims 1, 22, 35, and 36 recite a sampling tool comprising a sample tank having an internal fluid separator movably disposed therein, “the separator separating a sample chamber from a pressure balancing chamber in the sample tank, the sample chamber being in fluid communication with formation fluid concurrently with the pressure balancing chamber being in fluid communication with drilling fluid exterior to the pressure balancing chamber.” Original FIGURES 3A, 5A, and 6 support the amendments to claims 1, 22, 35, and 36 such that no new search should be required and no new matter has been added. The amendments are also supported by the original specification, for example, in Paragraphs [0031] and [0045].

12. Applicants respectfully submit that independent claims 1, 22, 35, and 36, as amended, distinguish patentably over *Ringgenberg et al.* in view of *Michaels et al.* Modification of the samplers 234 “of *Ringgenberg et al.* to include the internal fluid separator taught by *Michaels et al.*” as suggested by the Examiner would not result in “the sample chamber being in fluid communication with formation fluid concurrently with the pressure balancing chamber being in fluid communication with drilling fluid exterior to the pressure balancing chamber” as recited in amended claims 1, 22, 35, and 36.

13. *Ringgenberg et al.* teach an apparatus comprising a single longitudinal passage 270 for transporting both drilling fluid and formation fluid. Samplers 234 are deployed in an enlarged bore 230 in passage 270. The apparatus further includes upper and lower circulating valves 266 and 236 whose function is to switch the apparatus between drilling and formation evaluation configurations. As described in considerable detail in column 21 and Figures 3A and 3B of *Ringgenberg et al.*, circulating valves 266 and 236 have (i) drilling and (ii) formation evaluation positions. At column 21, lines 40-49, *Ringgenberg et al.* states:

When the two valves are in their drilling positions, it will be seen that central opening 274 of outer tubing string 202 is in communication with drill bit 212 so that drilling fluid or mud may be pumped downwardly through apparatus 200 during drilling operations. When the circulating valves are in their evaluation positions, communication is provided between seal bore 264 and sample chamber 230, and the sampling chamber is further in communication with sampling ports 238.

It is clear that when the valves 266 and 236 are in their “drilling positions”, the samplers 234 are immersed in drilling fluid (that is being pumped to the drill bit), but are not in fluid communication with formation fluid. When the valves 266 and 236 are in the “evaluation positions” the samplers 234 are immersed in formation fluid, but are not in fluid communication with the drilling fluid. As such, even if *Ringgenberg et al.* and *Michaels et al.* could be properly combined as suggested by the Examiner, the combination would not teach a “sample chamber being in fluid communication with formation fluid concurrently with the pressure balancing chamber being in fluid communication with drilling fluid exterior to the pressure balancing chamber” as recited in amended claims 1, 22, 35, and 36.

14. Further, Applicants respectfully submit that independent claims 1, 22, 35 and 36, as amended, are not taught or suggested by any other reference or combination of references of record.

15. In Paragraph 10 (pages 8 and 9) of the Office Action, claims 14-17, 32, 33, and 38 stand rejected under 35. U.S.C. 103(a) as being unpatentable over *Ringgenberg et al* in view of *Michaels et al* in further view of *Brown et al* (U.S. Patent 5,901,788). Applicants respectfully submit that this rejection is now moot in view of the above remarks and the amendments to claim 1, 22, 35, and 36.

16. Applicants therefore respectfully submit that independent claims 1, 22, 35, and 36, as amended, are patentable over the art of record. Independent claims 1, 22, and 36 being allowable, it follows *a fortiori* that dependent claims 2 through 21, 23 through 34, and 37 through 39 must also be allowable, since these dependent claims carry with them all the elements of the independent claims to which they ultimately refer.

17. In Paragraphs 11 and 12 of the Office Action, claims 1, 2, 6-8, 14-17, 20-26, 29, 32, 33, 36, and 38 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 5-7, 10, 16, 18, 25-30, and 37 of co-pending Application Serial No. 10/911,357. It should be noted that both applications (the instant application and 10/911,357) are commonly assigned, and that both claim priority to August 4, 2003, since the instant application was filed on the same day as U.S. Provisional Application Ser. No. 60/492,483 to which co-pending Application Serial No. 10/911,357 claims priority. It should be further noted that in regard to the claims amended in this paper in response to the obviousness rejections in the Office Action, these claims may no longer raise double patenting issues since the scope of these claims has changed. It should be further noted that in prosecution, 10/911,357 is currently on Final Rejection with no claims allowed. Applicants propose that filing a terminal disclaimer at this point may be premature. However, should claims ultimately be allowed in either the instant application and/or in

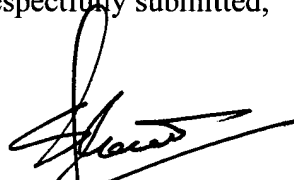
10/911,357, Applicants offer no objections to filing a terminal disclaimer at that time if the Examiner believes that there are still double patenting issues.

18. Applicants have reviewed the art deemed by the Examiner in Paragraph 13 of the Office Action to be pertinent, and believe that such art is less relevant than the references of record that the Examiner has cited and applied to the claims.

CONCLUSION

Applicants believe that in view of the foregoing remarks, pending claims 1 through 39 are allowable, and that this application is now in full condition for allowance, which action Applicants earnestly solicit. Should the Examiner have any questions, or believe that a telephone interview may expedite the further examination of this application, the Examiner is requested to contact the undersigned at the telephone number shown below.

Respectfully submitted,



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